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21839 7590 11/21/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER AUGHENBAUGH, WALTER	
			ART UNIT 1794	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/767,269

Applicant(s)

KAPPELER, KURT-ROBERT

Examiner

Walter B. Aughenbaugh

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-13,15,16 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 1,4 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. Applicant's amendments in claims 1, 4, 5, 11, 15, 16, 19 and 20 in the Amendment filed August 29, 2007 (Amdt. C) have been received and considered by Examiner.
2. Claim 1 is incorrectly labeled as "(Previously Presented)" in Amdt. C. Claim 1 is amended in Amdt. C, so it should be labeled as "(Currently Amended)".
3. New claims 21-24 presented in Amdt. C have been received and considered by Examiner.

### ***WITHDRAWN REJECTIONS***

4. The 35 U.S.C. 103 rejection of claim 4 made of record in paragraph 5 of the previous Office Action mailed May 3, 2007 has been withdrawn due to Applicant's amendment in claim 4 in Amdt. C.
5. The 35 U.S.C. 103 rejection of claim 5 made of record in paragraph 6 of the previous Office Action mailed May 3, 2007 has been withdrawn due to Applicant's amendment in claim 4 in Amdt. C.

### ***REPEATED REJECTIONS***

#### ***Claim Rejections - 35 USC § 103***

6. The 35 U.S.C. 103 rejection of claims 1, 3, 19 and 20 made of record in paragraph 5 of the previous Office Action mailed May 3, 2007 has been repeated for the reasons previously made of record, and for the following reasons that address the amendments made in claims 1, 19 and 20 in Amdt. C: in regard to claim 1, the recitations "constructed to allow... during manufacturing of the house [sic]" (lines 1-2) and "to determine the characteristic... during manufacturing of the hose" (lines 11-13) are intended use phrases that have not been given

patentable weight, since a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. In regard to the printed matter recitation “arranged in an order that indicates a characteristic of the hose” (lines 7-8), this printed matter recitation is not given patentable weight for the same reasons (based upon the guidelines set forth in MPEP 2112.01 III) that the printed matter recitations in the prior version of the claim (which are in the current version of the claim as well) have not been given patentable weight. See paragraph 5 of the previous Office Action mailed May 3, 2007.

In regard to claims 19 and 20, the recitations “the characteristic of the hose indicated by the marking sections is a date or a production number” of claim 19 and “the characteristic of the hose indicated by the marking sections is a material” of claim 20 are printed matter limitations that have not been given patentable weight based upon the guidelines set forth in MPEP 2112.01 III, including the *In re Gulack* holding, as discussed above in regard to claim 1, and in paragraph 5 of the previous Office Action mailed May 3, 2007, in regard to claims 1, 19 and 20.

7. The 35 U.S.C. 103 rejection of claims 6 and 11-13 made of record in paragraph 7 of the previous Office Action mailed May 3, 2007 has been repeated for the reasons previously made of record, taking into the account the reasons that address the amendments made in claim 1 in Amdt. C provided above in this Office Action, and for the following reason that addresses the amendment made in claim 11 in Amdt. C: the recitation “the ink has been applied to the hose by means of a printer” has not been given patentable weight since recitation of an item that is used to “appl[y]” a component of a claimed article to a substrate of the claimed article (in regard to claim 11, the inner layer among the two claimed layers corresponds to the substrate of the

claimed article) does recite any structural, compositional or any other type of limitation regarding the claimed article itself. Claim 11 positively recites a hose (that comprises ink), not a combination of the hose and a printer.

8. The 35 U.S.C. 103 rejection of claims 7 and 9 made of record in paragraph 8 of the previous Office Action mailed May 3, 2007 has been repeated for the reasons previously made of record, taking into the account the reasons that address the amendments made in claim 1 in Amdt. C provided above in this Office Action.

9. The 35 U.S.C. 103 rejection of claim 8 made of record in paragraph 9 of the previous Office Action mailed May 3, 2007 has been repeated for the reasons previously made of record, taking into the account the reasons that address the amendments made in claim 1 in Amdt. C provided above in this Office Action.

10. The 35 U.S.C. 103 rejection of claim 10 made of record in paragraph 10 of the previous Office Action mailed May 3, 2007 has been repeated for the reasons previously made of record, taking into the account the reasons that address the amendments made in claim 1 in Amdt. C provided above in this Office Action.

### ***NEW OBJECTIONS***

#### ***Claim Objections***

*II.* Claims 1, 4 and 23 are objected to because of the following informalities: “house” (line 2 of both claims 1 and 4, and line 3 of claim 23) should be appropriately amended. Appropriate correction is required.

***NEW REJECTIONS***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

13. Claims 4 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al. in view of Carden, Jr. et al.

In regard to claim 4, Stone et al. teach a multi-layer hose (balloon sheath, item 40) comprising three layers (col. 5, lines 32-36), where one of the two layers that are inside of the outer layer corresponds to the claimed inner layer (although the layer that corresponds to the inner layer is not explicitly taught as comprising rubber: see remainder of rejection). Stone et al. teach that the multi-layer hose comprises an outer layer (item 42) that is on (i.e. outside of, and connected to) the inner layer (col. 5, lines 29-36 and Fig. 2) and more than one marking sections (radiopaque marker, col. 5, lines 43-50) that are adapted to be read making use of X-rays (since the marking sections are radiopaque). Stone et al. teach that the outer layer (item 42) is made of rubber (col. 5, lines 51-57 and 32-36: elastomer such as latex or silicone). The first and second layers of Stone et al. are opaque because the materials of the layer are polymeric materials that are not disclosed as transparent (any layer that is not transparent has some degree of opacity). The layers of Stone et al. meet the structural limitation recited by “extruded” because the recitation “extruded”, when used to describe layers, does not recite any additional structure over that recited by “layer”.

The recitation “each first marking section comprising more than one letter and/or more than one number arranged in an order that indicates a characteristic of the hose” (lines 8-10) is a

printed matter recitation that has not been given patentable weight based upon the guidelines set forth in MPEP 2112.01 III:

III. PRODUCT CLAIMS - NONFUNCTIONAL PRINTED MATTER DOES  
NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE  
IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, \*\*>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

MPEP 2112.01 III.

The actual form of the markings does not define or contribute to the function of the device. The recitation "each marking section comprising more than one letter and/or more than one number" does not recite a new and unobvious functional relationship between the printed matter and the substrate; therefore, the printed matter recitation "each marking section

comprising more than one letter and/or more than one number” bears no patentable weight. *In re Gulack*. Furthermore, the fact that the claims fail to specify which languages, which numbering systems and/or code equivalents (Morse code, Braille, bar, etc...), if any, fall within the scope of the recitation “each marking section comprising more than one letter and/or more than one number” further supports the fact that the content/shape of the markings is not germane to the function of the device and therefore that these shape/content features bear no patentable weight.

The recitations “constructed to allow... during manufacturing of the house [sic]” (lines 1-2) and “to determine the characteristic... during manufacturing of the hose” (lines 10-12) are intended use phrases that have not been given patentable weight, since a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations.

The recitation “fuel hose for a motor vehicle” is an intended use phrase that has not been given patentable weight, since a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations.

Stone et al. teach that suitable materials for the markers are platinum and gold (col. 4, lines 51-57). Stone et al. teach that the marker bands enable visualization of the axial position of the sheath relative to other radiopaque structures, and that the markers are placed between the two layers of the two-layer embodiment of the invention (col. 5, lines 45-50).

Stone et al. fail to explicitly teach that the layer that corresponds to the inner layer (one of the two layers that are inside of the outer layer) is made of rubber and that the radiopaque



markers are arranged in a longitudinally spaced relationship with one another in a recurring mode of arrangement.

However, since Stone et al. teach that the hose may have three or more layers (col. 5, lines 32-36) and that the outer layer 42 comprises a rubber (col. 5, lines 51-57 and 32-36: elastomer such as latex or silicone), one of ordinary skill in the art would have recognized to have used an elastomeric material as the material of the layer that is in contact with the outer layer 42 of a three-layer hose of Stone et al. (or of a hose having four or more layers, col. 5, lines 32-36) since elastomeric material is a well known material for use as layers of a hose, particularly the outer layer or layers (the layers of the outer sleeve of Stone et al., col. 5, lines 51-57 and 32-36) of a hose as taught by Stone et al.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserted the marker bands between the outer layer of the three or more layer hose and the layer that is in contact with the outer layer of the three or more layer hose of Stone et al. since the markers are placed between the two layers of the two-layer embodiment of the invention (col. 5, lines 45-50), and since the markers would perform the equivalent function of enabling a medical professional to locate the position of the tube within the body with X-rays with the bands in the position identified above (between the two outermost layers) or in the position/s between other pairs of layers that are in contact with each other.

Furthermore, Carden, Jr. et al. disclose an implantable biomedical plastic strand (item 900, Fig. 11) that comprises bands of an X-ray absorbing material such as gold or platinum as radiopaque markers that are provided in a longitudinally spaced relationship with one another in a recurring mode of arrangement (Fig. 11 and col. 20, lines 30-35 and col. 21, lines 14-26).

Therefore, since Stone et al. teach that the marker bands enable visualization of the axial position of the sheath relative to other radiopaque structures (col. 5, lines 47-50), one of ordinary skill in the art would have recognized to have applied the radiopaque bands of Stone et al. in a longitudinally spaced relationship with one another in a recurring mode of arrangement along the hose of Stone et al. in order to enable a healthcare worker to precisely visualize the location of the hose within the body and of particular portions of the hose along its length (relative to other radiopaque structures as taught by Stone et al.) since it is well known to provide a medical implant with radiopaque markers in a longitudinally spaced relationship with one another in a recurring mode of arrangement for visualization of the device as taught by Carden, Jr. et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an elastomeric material as the material of the layer that is in contact with the outer layer 42 of a three-layer hose of Stone et al. (or of a hose having four or more layers, col. 5, lines 32-36) since elastomeric material is a well known material for use as layers of a hose, particularly the outer layer or layers (the layers of the outer sleeve of Stone et al., col. 5, lines 51-57 and 32-36) of a hose as taught by Stone et al. and to have applied the radiopaque bands of Stone et al. in a longitudinally spaced relationship with one another in a recurring mode of arrangement along the hose of Stone et al. in order to enable a healthcare worker to precisely visualize the location of the hose within the body and of particular portions of the hose along its length since it is well known to provide a medical implant with radiopaque markers in a longitudinally spaced relationship with one another in a recurring mode of arrangement for visualization of the device as taught by Carden, Jr. et al.

In regard to claim 21, Stone et al. and Carden, Jr. et al. teach the hose as discussed above in regard to claim 4.

Stone et al. and Carden, Jr. et al. fail to teach that the hose comprises a second outer layer made of rubber as recited in claim 21 where marking sections as recited in claim 4 are also located between the first outer layer and the second outer layer.

However, since Stone et al. teach that the hose may have three or more layers (col. 5, lines 32-36) and that the outer layer 42 comprises a rubber (col. 5, lines 51-57 and 32-36: elastomer such as latex or silicone), one of ordinary skill in the art would have recognized to have added an additional outer layer comprising an elastomeric material (for example, as the outermost layer of the hose) since hoses may have more than three layers are well known in the art as taught by Stone et al., and since it is well known to use a layer comprising an elastomeric material as the outer layer of a hose in the art as taught by Stone et al.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserted the marker bands between the first and second outer layers, in addition to between the first outer layer and the layer that is in contact with the first outer layer since the markers are placed between the two layers of the two-layer embodiment of the invention (col. 5, lines 45-50), and since the markers would perform the equivalent function of enabling a medical professional to locate the position of the tube within the body with X-rays with the bands in the position identified above (between the two outermost layers) or in the position/s between other pairs of layers that are in contact with each other, and would further assist with pinpointing the location of the tube within the body due to the additional markers and

due to the differences in locations of the markers along the radial direction of the tube (since the markers are located between two different pairs of layers).

In regard to claim 22, Stone et al. and Carden, Jr. et al. teach the hose as discussed above in regard to claim 4.

The recitation of claim 22 is a printed matter recitation that has not been given patentable weight based upon the guidelines set forth in MPEP 2112.01 III, as discussed above in this Office Action in regard to claim 4.

In regard to claim 23, Stone et al. teach a multi-layer hose (balloon sheath, item 40) consisting of an opaque, first layer (item 42), an opaque, second layer (item 44) connected to the first layer (col. 5, lines 29-32 and Fig. 2) and more than one marking sections that are arranged between the first layer and the second layer (radiopaque marker, col. 5, lines 43-50) and that are adapted to be read making use of X-rays (since the marking sections are radiopaque). The first and second layers of Stone et al. are opaque because the materials of the layer are polymeric materials that are not disclosed as transparent (any layer that is not transparent has some degree of opacity). The layers of Stone et al. meet the structural limitation recited by "extruded" because the recitation "extruded", when used to describe layers, does not recite any additional structure over that recited by "layer".

The recitations "constructed to allow... during manufacturing of the house [sic]" (lines 1-3) and "to determine the characteristic... during manufacturing of the hose" (lines 10-12) are intended use phrases that have not been given patentable weight, since a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations.

The recitation "fuel hose for a motor vehicle" is an intended use phrase that has not been given patentable weight, since a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations.

The recitation "each marking section comprising more than one letter and/or more than one number" is a printed matter limitation that has not been given patentable weight based upon the guidelines set forth in MPEP 2112.01 III:

III. PRODUCT CLAIMS - NONFUNCTIONAL PRINTED MATTER DOES  
NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE  
IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, \*\*>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

MPEP 2112.01 III.

The actual form of the markings does not define or contribute to the function of the device. The recitation “each marking section comprising more than one letter and/or more than one number” does not recite a new and unobvious functional relationship between the printed matter and the substrate; therefore, the printed matter recitation “each marking section comprising more than one letter and/or more than one number” bears no patentable weight. *In re Gulack*. Furthermore, the fact that the claims fail to specify which languages, which numbering systems and/or code equivalents (Morse code, Braille, bar, etc...), if any, fall within the scope of the recitation “each marking section comprising more than one letter and/or more than one number” further supports the fact that the content/shape of the markings is not germane to the function of the device and therefore that these shape/content features bear no patentable weight.

Stone et al. teach that suitable materials for the markers are platinum and gold (col. 4, lines 51-57). Stone et al. teach that the marker bands enable visualization of the axial position of the sheath relative to other radiopaque structures (col. 5, lines 47-50).

Stone et al. fail to explicitly teach that the radiopaque markers are provided in a longitudinally spaced relationship with one another in a recurring mode of arrangement.

Carden, Jr. et al. disclose an implantable biomedical plastic strand (item 900, Fig. 11) that comprises bands of an X-ray absorbing material such as gold or platinum as radiopaque markers that are provided in a longitudinally spaced relationship with one another in a recurring mode of arrangement (Fig. 11 and col. 20, lines 30-35 and col. 21, lines 14-26). Therefore, since Stone et al. teach that the marker bands enable visualization of the axial position of the sheath relative to other radiopaque structures (col. 5, lines 47-50), one of ordinary skill in the art would have

recognized to have applied the radiopaque bands of Stone et al. in a longitudinally spaced relationship with one another in a recurring mode of arrangement along the hose of Stone et al. in order to enable a healthcare worker to precisely visualize the location of the hose within the body and of particular portions of the hose along its length (relative to other radiopaque structures as taught by Stone et al.) since it is well known to provide a medical implant with radiopaque markers in a longitudinally spaced relationship with one another in a recurring mode of arrangement for visualization of the device as taught by Carden, Jr. et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the radiopaque bands of Stone et al. in a longitudinally spaced relationship with one another in a recurring mode of arrangement along the hose of Stone et al. in order to enable a healthcare worker to precisely visualize the location of the hose within the body and of particular portions of the hose along its length since it is well known to provide a medical implant with radiopaque markers in a longitudinally spaced relationship with one another in a recurring mode of arrangement for visualization of the device as taught by Carden, Jr. et al.

In regard to claim 24, Stone et al. and Carden, Jr. et al. teach the hose as discussed above in regard to claim 23. Stone et al. teach that the outer layer (item 42) is made of rubber (col. 5, lines 51-57 and 32-36: elastomer such as latex or silicone).

Stone et al. and Carden, Jr. et al. fail to teach that the inner layer is made of rubber.

Stone et al., however, disclose that the inner layer is made from a material that is relatively inelastic (compared with the material of the outer layer), and does not require that the material is "substantially noncompliant at typical balloon inflation pressures": this is a preferred embodiment (col. 5, line 65-col. 6, line 6). Therefore, one of ordinary skill in the art would have

recognized to have used a rubber (elastic material) that is less elastic than the material of the outer layer of the hose taught by Stone et al. and Carden, Jr. et al. since elastic material is a well known material for use in hoses in the art as taught by Stone et al. and since a material that is less elastic than the material of the outer layer should be used as the material of the inner layer of the hose of Stone et al. as taught by Stone et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a rubber (elastic material) that is less elastic than the material of the outer layer of the hose taught by Stone et al. and Carden, Jr. et al. since elastic material is a well known material for use in hoses in the art as taught by Stone et al. and since a material that is less elastic than the material of the outer layer should be used as the material of the inner layer of the hose of Stone et al. as taught by Stone et al.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al. in view of Carden, Jr. et al. and in further view of Hostettler et al.

Stone et al. and Carden, Jr. et al. teach the hose as discussed above in regard to claim 4.

Stone et al. teach that the outer later, item 42, is formed from a wide variety of elastic materials (col. 5, lines 51-57).

Stone et al. and Carden, Jr. et al. fail to explicitly teach that the rubber is an ethylene acrylate rubber.

Hostettler et al., however, disclose that ethylene/alkyl acrylate copolymer rubbers are a suitable material for use in catheters (col. 9, lines 6-13). Therefore, one of ordinary skill in the art would have recognized to have used the ethylene/alkyl acrylate copolymer rubber taught by Hostettler et al. as the elastic material of the two outermost layers of the hose taught by Stone et



al. and Carden, Jr. et al. since ethylene/alkyl acrylate copolymer rubber is a well known material for use in catheters as taught by Hostettler et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the ethylene/alkyl acrylate copolymer rubber taught by Hostettler et al. as the elastic material of the two outermost layers of the hose taught by Stone et al. and Carden, Jr. et al. since ethylene/alkyl acrylate copolymer rubber is a well known material for use in catheters as taught by Hostettler et al.

#### ***Response to Arguments***

15. Applicant's arguments presented on pages 9-14 of Amdt. C regarding the 35 U.S.C. 103 rejection of claim 1 have been fully considered but are not persuasive.

Applicant argues that the printed matter recitations must be given weight since the function of the hose is "to allow tracing back of individual process steps performed during manufacturing of the house [sic]", but this is not the function of the hose. "[T]o allow tracing back of individual process steps performed during manufacturing of the house [sic]" is the function of the printed matter, but is not the function of the hose. One of ordinary skill in the art recognizes that the function of a hose is to convey some substance through the hose from one location to another.

Applicant attempts to equate the facts of the instant application with the facts in the *Ngai* case (see page 11), but whereas in *Ngai* the printed matter and the band required each other for the educational product to perform the function of the educational product of educating the user of the educational product (the product would not have been an educational product without the printed matter or without the band), the hose of the instant application can perform its function of

conveying some substance through the hose from one location to another without the printed matter. The printed matter is not required for the hose to perform its function of conveying some substance through the hose from one location to another. The printed matter is not related to the function of the hose of conveying some substance through the hose from one location to another. Only the layers of the hose are required for the hose to perform its function of conveying some substance through the hose from one location to another. As demonstrated above, the *Ngai* case does not apply to the facts of the instant application because the printed matter and the layers of the hose do not require each other for the hose to perform its function of conveying some substance through the hose from one location to another, whereas in *Ngai* the printed matter and the band required each other for the educational product to perform the function of the educational product of educating the user of the educational product.

16. Applicant's arguments presented on pages 14-16 of Amdt. C regarding the remainder of the 35 U.S.C. 103 rejections depend upon Applicant's arguments presented on pages 9-14 of Amdt. C regarding the 35 U.S.C. 103 rejection of claim 1, which have been addressed above in this Office Action.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

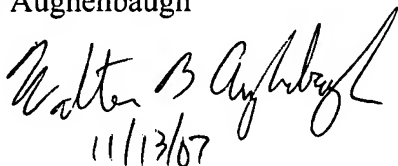
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Walter B. Aughenbaugh  
11/13/07



11/13/07